

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF  
THE TTAB

**UNITED STATES PATENT AND TRADEMARK  
OFFICE**

Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

Butler

**Mail date: November 22, 2004**

**Opposition No. 91160758**

**Pan American Coffee Co., Ltd.**

**v.**

**Caracolillo Coffee Mills, Inc.**

**Before Seeherman, Walters and Holtzman, Administrative Trademark  
Judges.**

**By the Board:**

Applicant seeks to register the following mark

**CAFÉ CARACOLILLO**

for "coffees."<sup>1</sup> As grounds for the opposition, opposer alleges that it has been using the mark CAFÉ CARACOLILLO since 1951 in the Northeast United States including, but not limited to, the states of New York, New Jersey, Connecticut, and Pennsylvania; that applicant knew of opposer's prior rights in opposer's trading area when applicant filed its application; and that applicant's mark, when used on the identified goods, so resembles opposer's mark, previously used in opposer's trading area, as to

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<sup>1</sup> Application Serial No. 75667025, filed on July 20, 1999, claiming first use since 1936 and first use in commerce since 1950. Applicant has disclaimed the term CAFÉ and has provided a translation of CARACOLILLO as "snail shell."

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be likely to cause confusion, mistake or to deceive. Opposer also alleges that it has pending a concurrent use application for its CAFÉ CARACOLILLO mark for "coffee."<sup>2</sup>

In lieu of an answer, applicant filed, on July 14, 2004, a motion to dismiss the opposition based on the Board's decision in Opposition No. 91120415,<sup>3</sup> which involved the same parties and the same marks. Applicant asserts that opposer's claim in the present proceeding is barred by the doctrine of claim preclusion, and submits with its answer a copy of the Board's decision in the earlier opposition. Opposer filed a response to applicant's motion.

As a procedural matter, if, on a motion to dismiss, matters outside the pleadings are submitted and not excluded by the Board, the motion will be treated as a motion for summary judgment. Inasmuch as applicant's motion is predicated on the prior Board decision and, thus, involves matters outside the pleadings, said motion will be treated as one for summary judgment. Although the Federal Rules of Civil Procedure and Board practice provide that both parties be given a reasonable opportunity to present all materials made pertinent to such a converted motion, the Board finds it unnecessary under the

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<sup>2</sup> Application Serial No. 76532622, filed on July 25, 2003, claiming first use and first use in commerce since January 1951. A translation of CARACOLILLO as "snail shell" has been provided.

<sup>3</sup> In previous Board records, the "91" prefix, signifying an opposition for purposes of database management, did not precede the opposition number, e.g. 120415. It is now Board practice to include this prefix with all opposition numbers.

present circumstances. *See Selva & Sons, Inc. v. Nina Footwear, Inc.*, 705 F.2d 1316, 217 USPQ 641 (Fed. Cir. 1983). *See also* Fed. R. Civ. P. 12; and TBMP §§503.04 and 504.03 (2<sup>nd</sup> ed. rev. 2004).

In a motion for summary judgment, the moving party has the burden of establishing the absence of any genuine issue of material fact and that it is entitled to judgment as a matter of law. *See* Fed. R. Civ. P. 56. A genuine dispute with respect to a material fact exists if sufficient evidence is presented that a reasonable fact finder could decide the question in favor of the non-moving party. *See Opryland USA Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992). Thus, all doubts as to whether any particular factual issues are genuinely in dispute must be resolved in the light most favorable to the non-moving party. *See Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ 1542 (Fed. Cir. 1992).

Under the doctrine of claim preclusion (*res judicata*), the entry of a final judgment "on the merits" of a claim (i.e., cause of action) in a proceeding serves to preclude the relitigation of the same claim in a subsequent proceeding between the parties or their privies, even in those cases where the prior judgment was the result of a default or consent. *See Lawlor v. National Screen Service Corp.*, 349 U.S. 322, 75 S.Ct. 865, 99 L.Ed. 1122 (1955); *Chromalloy American Corp. v. Kenneth Gordon, Ltd.*, 736

F.2d 694, 222 USPQ 187 (Fed. Cir. 1984); and *Flowers Industries, Inc. v. Interstate Brands Corp.*, 5 USPQ2d 1580 (TTAB 1987).

Turning now to the specifics of this case, in support of its motion applicant argues that the Board previously ruled that applicant is the "absolute" prior user of the mark CAFÉ CARACOLILLO.<sup>4</sup> Applicant argues that the parties in the present proceeding and the prior opposition are the same; that the marks are the same; and that the goods are the same, coffee. Applicant contends that, under the doctrine of *res judicata*, it is entitled to judgment in its favor. In addition, relying on *U.S. Soil, Inc. v. Colovic*, 214 USPQ 471 (TTAB 1982), applicant argues that opposer's assertion in the present opposition of relative prior rights in a limited geographic area is insufficient to support the opposition.

In response, opposer acknowledges that the Board previously determined that opposer was not entitled to an unrestricted registration. However, according to opposer, it has filed a concurrent use registration naming applicant as an exception to opposer's claim of exclusive use. Opposer argues that applicant does not contest that opposer is the senior user in opposer's named trading area; that neither party is entitled to an unrestricted registration; and that the proper venue for resolution of the parties' respective rights is a concurrent use

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<sup>4</sup> *Caracolillo Coffee Mills, Inc. v. Pan American Coffee Co., Ltd.*, Opposition No. 120,415 (TTAB August 21, 2002).

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proceeding. Opposer requests suspension of the present opposition pending institution of a concurrent use proceeding involving its pending concurrent use application.

The summary judgment decision in Opposition No. 91120415 granted judgment in favor of Caracolillo Coffee Mills (CCM), as opposer therein, on the issues of priority and likelihood of confusion. This prior decision involved the same parties, the same marks, and the same goods.<sup>5</sup> The Board found that no genuine issue of material fact existed and that the parties' marks and goods were identical. There being no restriction in either party's identification of goods, the Board also found that no genuine issue of material fact existed and that the channels of trade and classes of purchasers were identical. Pan American Coffee (PAC), as applicant in the earlier proceeding, submitted no evidence regarding its use of the mark and, thus, could rely only on the filing date of its application which was the subject matter of Opposition No. 91120415 (April 27, 1999). CCM, on the other hand, by way of the declarations of two of its officers, established first use since 1936, long prior to the filing date of PAC's application. Thus, the Board found that no genuine issue of material fact existed as to priority, and that CCM was the prior user of the mark CAFÉ CARACOLILLO. With respect to

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<sup>5</sup> Indeed, applicant, as opposer in the earlier opposition, relied upon its ownership of application Serial No. 75667005, the subject matter of the present opposition, then pending before the Trademark Law Offices.

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PAC's arguments that the parties use their marks in different geographic areas and that a concurrent use proceeding would be appropriate, the Board commented that geographic restrictions cannot be determined in the context of an opposition proceeding.

In *U.S. Soil, Inc. v. Colovic, supra*, the question was framed as follows:

Should an opposition proceed where it has been established as a result of prior litigation that applicant has superior rights in a confusingly similar mark and where opposer only alleges that it has rights in certain geographic areas. *Id.* at 472.

The Board answered that question in the negative and further instructed that the appropriate forum for the adjudication of concurrent rights at the USPTO is a concurrent use proceeding. *Id.* See also Trademark Rules 2.99(h) and 2.133(c).

We consider the same question. In this case, the parties are the same, the involved marks and goods are the same, and the claims that may be considered in this opposition are the same as those determined on summary judgment in Opposition No. 91120415. The final judgment in Opposition No. 91120415 precludes relitigation of issues that were or could have been raised in that action. Thus, applicant's superior rights having been established previously, applicant is entitled to an unrestricted registration despite whatever regional rights opposer may have as a junior user. *Id.* Nonetheless, this decision does not preclude opposer from seeking a concurrent use registration if it does

indeed have lawful use prior to the filing date of the opposed application. *Id.* See also Trademark Act §2(d).

In view thereof, opposer's request to suspend this opposition pending institution of a concurrent use proceeding involving its concurrent use application is denied; and the opposition is dismissed.<sup>6</sup>

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<sup>6</sup> In the event that opposer's now pending concurrent use application Serial No. 76532622 is published for opposition subject to concurrent use rights (and is not opposed, or all oppositions are dismissed), a concurrent use proceeding will be instituted before the Board. See TBMP §1106.02. It is in the context of any such concurrent use proceeding that geographic limitations will be considered, and any resulting concurrent use rights will be determined.